

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 13, 14, 18, and 19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,462,051 to Oka et al. (hereinafter "Oka"). Additionally, the Examiner rejects claims 1-6, 8, and 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,576,972 to Harrison (hereinafter "Harrison") in view of U.S. Patent No. 5,505,199 to Kim (hereinafter "Kim"). Additionally, the Examiner rejects claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Harrison in view of U.S. Patent No. 6,062,216 to Corn (hereinafter "Corn"). Furthermore, the Examiner rejects claims 10-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,160,478 to Jacobsen et al. (hereinafter "Jacobsen") in view of Oka. Still further, the Examiner rejects claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Oka in view of Corn. Lastly, the Examiner rejects claims 16 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Oka in view of U.S. Patent No. 5,012,522 to Lambert (hereinafter "Lambert").

In response, Applicants respectfully traverse the Examiner's rejections for at least the reasons set forth below.

With respect to independent claim 1, the Examiner argues that Harrison discloses all of the features of claim 1 with the exception of classifying an alarm condition threatening to the person, for which he cites Kim. Applicants respectfully disagree.

Firstly, the Examiner again fails to give weight to the recitations in claim 1 of a "device for monitoring a first person **requiring supervision.**" Nowhere in Harrison is it taught or suggested to monitor a person requiring supervision. Harrison is directed to an area monitoring system (see Title of the Invention as well as preamble of claims). Harrison

monitors an area for detection of an intruder or for the purpose of theft deterrence. Column 10, line 45 to column 11, line 4 contemplates several examples of intruder detection and theft deterrence, such as monitoring an established perimeter, providing after hour security at an auto show, monitoring underwater activity, monitoring valuable property, detection of unauthorized personnel or objects entering a monitored space, and providing security on a movie location for valuable equipment when the equipment is not in use. Harrison does not teach, contemplate or suggest monitoring a first person requiring supervision.

In the Examiner's response to the previous arguments, the Examiner argues that the limitation "a device for monitoring a first person requiring supervision" was not found in the body of the claim and therefore cannot be given patentable weight."

Although the term "requiring supervision" is not found in the body of the claim, the person is defined in the preamble as "requiring supervision" and therefore any subsequent recitation of "the person" in the body of the claim is assumed to be the person recited in the preamble, namely, the person "requiring supervision." Thus, applicants respectfully submit that the person requiring supervision is inherently recited throughout the body of the claim.

Furthermore, the Court of Appeals for the Federal Circuit has held that the preamble should be given patentable weight where the preamble "is necessary to give life, meaning, and vitality to the claim. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298 (Fed. Cir. 1999). Applicants respectfully submit that claim 1 meets the requirements of the Federal Circuit and the preamble thereof must be given patentable weight. Claim 1 recites that an alarm condition threatening to the person is classified in response to the environment monitor. Thus, the "person requiring supervision" is necessary to give life and meaning to the

claim or else the condition threatening to the person would not be relevant to the claimed apparatus.

Thus, Applicants respectfully submit that the combination of Harrison and Kim does not disclose or suggest all of the features of claim 1.

Secondly, the Examiner argues that Kim discloses "said controller being programmed to classify at least one alarm condition **threatening to said first person**" and that "it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Harrison, so that a threatening condition can be monitored, as taught by Kim, so as to seek the benefit of enhanced system flexibility." Applicants respectfully disagree and submit that the Examiner has used impermissible hindsight in combining the Harrison and Kim references.

As discussed above, Harrison monitors an area for detection of an intruder or for the purpose of theft deterrence. Harrison does not teach or suggest that the system disclosed therein be used for the purpose of monitoring a person for an alarm condition that is threatening to the person. Therefore, those of ordinary skill in the art with the knowledge of Harrison would not be motivated or suggested to look to the system of Kim which is directed to a different field of endeavor (monitoring the health of a child) and which is directed to solving a different problem (prevention of sudden infant death syndrome). Therefore, Applicants respectfully submit that the combination of Harrison and Kim is improper and must be withdrawn. Applicants further submit that because Kim is directed to a different field of endeavor and to solving a different problem, it is also from a non-analogous art and must be withdrawn.

With respect to independent claim 13, the Examiner argues that Oka discloses all of the features of claim 13. Applicants again respectfully disagree. Oka is directed to a **medical communication system**, in which a physical information of a patient is remotely monitored and transmitted remotely through a telephone network, such as to a doctor at a hospital (see column 7, line 29 to column 8, line 21 for a summary). The medical communication system of Oka also transmits the voices of the patient and/or a caregiver, such as a nurse, to the doctor where the voice signals are multiplexed for transmission and demultiplexed at the remote location, from each other and also from a physical information signal transmitted with the voice signals. The voice of the doctor can also be transmitted from the doctor back to the site of the patient and caregiver. Thus, Oka merely teaches a medical communication system which monitors a physical condition of only a patient and transmits signals representative of the physical condition remotely to a doctor and also transmits voice signals to and from the doctor.

As discussed above, Oka does not monitor the state of a caregiver of a person, but merely provides a communication link between the person and caregiver to a remote location, such as a hospital. The Examiner argues that Oka discloses the step of detecting behavior of a person other than a person being tested at column 6, lines 3-5. Applicants respectfully disagree. Oka merely teaches transmitting the voice of the patient and/or attendant (48) to the doctor (50) at the remote location.

The Examiner reads the detecting step and wherein clause of claim 13 as separate features of the claim. However, they must be read together because the detecting step recites detecting an event requiring the attention of a remote supervisor and the wherein clause further specifies that the detecting includes detecting a behavior of a person other than

the person. Firstly, Applicants respectfully submit that the detection of the attendant's voice is not a behavior of the attendant. Furthermore, even if the transmission of the attendant's voice to the doctor may be considered to be the detection of a behavior of the attendant, it is not the detection of "an event requiring the attention of a remote supervisor" as recited in claim 13. The transmission of the attendant's voice to the doctor (remote supervisor) is merely to carry out the instructions of the doctor or to relay any information to the doctor regarding the patient.

With regard to claim 10, the Examiner now rejects the same over the combination of Jacobsen and Oka. The Examiner argues that all of the features of claim 10 are disclosed in Jacobsen with the exception of one of the people being a caretaker of a patient, for which he cites Oka. Applicants respectfully disagree.

Jacobsen teaches a wireless health monitoring system in which a patient wears a sensor that can detect the patient falling and can wirelessly transmit a signal to a person monitoring the patient. The sensor can be worn by more than one patient in different locations.

Firstly, Applicants respectfully submit that Oka does not teach or disclose monitoring a state of a caretaker. As discussed above, Oka merely discloses transmitting the voice of the attendant to the Doctor at the remote location. The transmission of the attendant's voice cannot be said to be monitoring the state of the caregiver.

Secondly, the Examiner argues that "it would have been obvious to one or ordinary skill in the art, at the time of the invention, to modify Jacobsen et al, so that one of the two people being monitored is a caretaker, as taught by Oka et al, so as to derive the

benefit of improved system flexibility." Applicants respectfully disagree and submit that the Examiner has used impermissible hindsight in combining the Jacobsen and Oka references.

As discussed above, Jacobsen teaches monitoring patients that may be at different locations. Therefore, Jacobson does not teach or suggest that one of the patients can be a caregiver and those of ordinary skill in the art would not be motivated or suggested to combine the same with a reference that teaches monitoring a patient and a caregiver. Furthermore, as discussed above, Oka does not teach or suggest monitoring the health or safety of the caregiver. Therefore, Applicants respectfully submit that the combination of Jacobsen and Oka is improper and must be withdrawn.

With regard to claims 15 and 16, since independent claim 13 patentably distinguishes over the prior art and is allowable, claims 15 and 16 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 15 and 16 under 35 U.S.C. § 103(a).

With regard to the rejections of claims 1-6, 8, and 9 under 35 U.S.C. § 103(a), independent claim 1 is not rendered obvious by the cited references because neither the Harrison patent nor the Kim patent, whether taken alone or in combination, teach or suggest a device for monitoring a first person requiring supervision having the features described above. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 2-6, 8, and 9, being dependent upon claim 1, are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-6, 8, and 9 under 35 U.S.C. § 103(a):

With regard to claim 7, since independent claim 1 patentably distinguishes over the prior art and is allowable, claim 7 is at least allowable therewith because it depends from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 7 under 35 U.S.C. § 103(a).

With regard to the rejections of claims 10-12 under 35 U.S.C. § 103(a), independent claim 10 is not rendered obvious by the cited references because neither the Jacobsen patent nor the Oka patent, whether taken alone or in combination, teach or suggest a monitoring system for monitoring the environment of a person requiring supervision having the features described above. Accordingly, claim 10 patentably distinguishes over the prior art and is allowable. Claims 11 and 12, being dependent upon claim 10, are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 10-12 under 35 U.S.C. § 103(a).

With regard to the rejection of claims 13, 14, 18, and 19 under 35 U.S.C. § 102(b), a method for monitoring a person requiring supervision having the features discussed above and as recited in independent claim 13 are nowhere disclosed in Oka. Since it has been decided that “**anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,**”¹ independent claim 13 is not anticipated by Oka. Accordingly, independent claim 13 patentably distinguishes over Oka and is allowable. Claims 14, 18, and 19 being dependent upon claim 13, are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 13, 14, 18, and 19 under 35 U.S.C. § 102(b).

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

With regard to claim 20, the same has been canceled thereby rendering the rejection thereof moot.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', with a stylized flourish at the end.

Thomas Spinelli

Registration No.: 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

TS/cm